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16 UNITED STATES DISTRICT COURT

17 NORTHERN DISTRICT OF CALIFORNIA

18 SAN FRANCISCO DIVISION

19 ORACLE AMERICA, INC.

20 Case No. 3:10-cv-03561-WHA

21 Plaintiff,

22 Honorable Judge William Alsup

23 v.

24 GOOGLE INC.
25 Defendant.
**GOOGLE'S RESPONSE IN OPPOSITION
TO ORACLE'S MOTION TO AMEND
'205 PATENT INFRINGEMENT
CONTENTIONS AND SUPPLEMENT
EXPERT REPORTS**

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1 Oracle's Motion to Amend Infringement Contentions for the '205 patent ("Motion," Dkt.
 2 No. 782) is now moot in view of the Court's Order setting a date for trial and Oracle's offer to
 3 dismiss with prejudice the '205, '702, and '720 patents. (Dkt. No. 786.) Oracle has
 4 acknowledged that its Motion would be moot if trial goes forward in the spring. (Motion at 1.)
 5 And the Court has now scheduled trial for the spring. (Dkt No. 786.) Google therefore suggests
 6 that Oracle withdraw its motion, or that the Court deny it as moot. In any event, pursuant to the
 7 Court's Order for Google to respond to Oracle's Motion on March 16 (Dkt. No. 774), Google
 8 hereby responds to the Motion.

9 **I. ORACLE'S AMENDMENT IMPROPERLY INTRODUCES A NEW INFRINGEMENT
 10 THEORY ON THE EVE OF TRIAL**

11 As summarized in Google's opposition to Oracle's Précis letter in this dispute (Dkt. No.
 12 758), Oracle's infringement theory as to the '205 patent has always been directed at the time
 13 when an application is *running* in the Dalvik virtual machine, whereas Oracle now wants to
 14 assert an infringement theory directed at the replacement of certain virtual machine instructions
 15 at the time when an application is first *installed* on a device.

16 The crux of the issue is that Oracle has mistakenly asserted throughout this case that the
 17 accused dexopt functionality is part of the Dalvik virtual machine and operates when
 18 applications are executed, but now realizes that its infringement theory is inherently flawed –
 19 dexopt is an independent process in Android that *optimizes* an application's virtual machine
 20 instructions distinctly before the time when the Dalvik virtual machine *executes* that
 21 application's virtual machine instructions. In other words, Oracle finally recognizes that dexopt
 22 does not optimize an application that is running in the Dalvik virtual machine, but rather at
 23 "install time," *i.e.*, when an application is first installed on a device. Now, on the eve of trial,
 24 Oracle is attempting to use the Court's construction of "runtime" from over a month ago as an
 25 excuse to inject a different theory into the case in order to correct this fatal error in its
 26 infringement contentions (as well as in the report and deposition testimony of its expert).
 27 Specifically, Oracle now seeks permission to allege – for the first time – that the install time
 28 implementation of dexopt infringes the '205 patent.

1 In an unsolicited reply to Google’s opposition letter, Oracle accused Google of making
 2 “misleading or false characterizations,” and protested that “Oracle’s infringement theory has
 3 always been directed to the time ***when Android’s dexopt is running.***” (Dkt. No. 765 at 1
 4 (emphasis added).) But Oracle’s new argument that its “runtime” infringement theory relates to
 5 “when Android’s dexopt is running” (which Oracle now recognizes occurs *at install time*)
 6 directly contradicts its own claim chart, which alleges that “runtime” occurs when optimized
 7 virtual machine instructions are being executed by the Dalvik virtual machine (*i.e.*, when an
 8 application is running, *after* install time). (*See* Ex. A to Peters Decl. (Dkt. No. 783) at 2
 9 (“Android uses the Dalvik virtual machine to execute virtual machine bytecode instructions at
 10 runtime. The Dalvik virtual machine performs and runs code resulting from certain
 11 optimizations to increase the execution speed of virtual machine instructions at runtime”).)

12 Oracle’s newfound assertion that “runtime” equates with dexopt operating independently
 13 at install time also contradicts repeated statements by its own infringement expert, Dr. Mitchell.
 14 His expert report states that “[t]he dexopt component that ***runs in the Dalvik virtual machine***
 15 loads virtual machine instructions into the virtual machine” (Ex.A, Expert Report of Dr.
 16 Mitchell at ¶ 397 (emphasis added).)¹ Dr. Mitchell further explains that “Android uses the
 17 Dalvik virtual machine to execute virtual machine bytecode instructions at runtime,” reiterating
 18 that “[t]he Dalvik virtual machine – and here dexopt in particular – performs and runs code.”
 19 (*Id.* at ¶ 400.) Having thus linked dexopt to the Dalvik virtual machine and linked the Dalvik
 20 virtual machine to the execution of applications, Dr. Mitchell concludes that dexopt meets the
 21 “runtime” limitation of the ‘205 patent. (*Id.* at ¶¶ 403; 409-410.)

22 Dr. Mitchell’s Reply Report likewise argues that “[t]he optimizations that dexopt
 23 performs (such as replacing symbolic references with vtable offsets) are ones that require
 24 information that is only available at runtime (such as a vtable offset), and that information is
 25 obtained ***by initializing a Dalvik VM and loading all the classes from an application’s .dex file***

27 ¹ Google’s exhibits are attached to the Declaration of Mark H. Francis in Support of Google’s Response in
 28 Opposition to Oracle’s Motion to Amend ‘205 Patent Infringement Contentions and Supplement Expert Reports.

1 **into the VM.”** (Ex. B, Reply Expert Report of Dr. Mitchell at ¶ 60 (emphasis added).) During
 2 his deposition, Dr. Mitchell reiterated this point, stating “then **the run process of executing** [] in
 3 the Dalvik Virtual Machine, I believe, was [] where the dexopt got invoked.” (Ex. C, Mitchell
 4 Dep. at 342; *see also id.* at 344 (“My recollection, at least in that – those experiments [described
 5 in the report], was that [dexopt] runs as part of the – as a component of the virtual machine. And
 6 so in – whatever the human input it is that triggers that process, dexopt runs as part of execution
 7 on the virtual machine.”) (emphasis added).)

8 Oracle’s Motion relies heavily on a portion of its original infringement claim chart that
 9 block-quoted Android documentation, and appears to argue that this represents that it had
 10 initially accused dexopt functionality that operates at install time. *See* Motion at 7 (quoting
 11 Peters Decl. Ex. A at 13):

12 The system tries to pre-verify all classes in a DEX file to reduce
 13 class load overhead, and performs a series of optimizations to
 14 improve runtime performance. Both of these are done by the dexopt
 15 command, either in the build system or by the installer. On a
 16 development device, dexopt may be run the first time a DEX file is
 17 used and whenever it or one of its dependencies is updated (“just-
 18 in-time” optimization and verification).

19 This is a novel reading of Oracle’s original allegations. Oracle’s original claim chart largely
 20 consisted of copy-and-paste blocks of Android code or documentation without explanation, and
 21 Oracle cannot now argue that its original dexopt infringement theory involved install time when
 22 the **only time** the word “install[er]” shows up anywhere in its entire original claim chart is in this
 23 block quote, without any explanation, and where the only theory advanced by Oracle’s
 24 infringement expert – in both deposition and his expert reports – related to the time when an
 25 application is executing, not when it is being installed on a device.

26 Thus, the record confirms that Oracle is indeed improperly changing its infringement
 27 theory on the eve of trial: until just weeks ago, it clearly and consistently took the position that
 28 the “runtime” claim limitation was practiced because dexopt operates as part of the Dalvik
 virtual machine during the time when the virtual machine instructions of an application are being
 executed.

1 **II. ORACLE DOES NOT HAVE GOOD CAUSE TO AMEND ITS CONTENTIONS**

2 Oracle's contention that the Court's claim construction order (over a month ago) justifies
 3 its requested amendment is without merit and should be rejected. The Court's claim construction
 4 order did not adopt any construction that provides good cause for amendment, and Patent L.R. 3-
 5 6 does not permit a party to swap in new infringement theories to fix technical failings.

6 Indeed, the inherent inconsistencies of Oracle's own arguments underscore why its
 7 argument should be rejected. Oracle claims that in adding these two new paragraphs to its
 8 infringement contentions, "Oracle is not altering its infringement theory. The Android code
 9 accused of satisfying the claim limitation is the same before and after the proposed
 10 supplementation." (Motion at 1.) Yet, if that were truly the case, then Oracle cannot claim that
 11 the Court's claim construction of "runtime" somehow provides a basis for Oracle to supplement
 12 its infringement theory, if its infringement theory has always been the same. And given that the
 13 accused Android code has not changed, Oracle has no excuse for waiting until the eve of trial to
 14 supplement its infringement contentions with material that has been publicly available for years.

15 Put another way, Oracle only has good cause to amend its contentions if the Court's
 16 construction amended its existing infringement theory in some way. But Oracle claims that its
 17 theory remains the same. Oracle cannot have it both ways – either its new theory is different and
 18 injecting a new theory at this late hour is recognizably prejudicial to Google, or its theory
 19 remains the same and Oracle was simply delinquent for not amending its claim chart early in
 20 discovery, but rather waiting until the eve of trial to amend. Either way, Oracle's motion should
 21 be rejected because it fails to provide good cause for amending infringement contentions at this
 22 late date in a manner that would not be highly prejudicial to Google.

23 **A. Oracle Was Not Diligent in Amending Contentions During Discovery**

24 This Court has previously ruled that, under Patent Local Rule 3-6, "good cause requires a
 25 showing of diligence," and without such diligence, good cause is irrelevant. *Oracle Am., Inc. v.*
26 Google Inc., No. 10-cv-03561-WHA, 2011 U.S. Dist. LEXIS 87251 at *7 (N.D. Cal. Aug. 8,
 27 2011); *see also Acer, Inc. v. Tech. Props.*, Nos. 5:08-cv-00877, 00882, 05398, 2010 U.S. Dist.

1 LEXIS 142472, at *17 (N.D. Cal. Sept. 10, 2010) (stating that, “[b]ecause [the moving party]
 2 has not demonstrated diligence, the inquiry should end”); *O2 Micro Int'l Ltd. v. Monolithic*
 3 *Power Sys., Inc.*, 467 F.3d 1355, 1366-68 (Fed. Cir. 2006) (concluding that if a party seeking to
 4 amend did not demonstrate diligence, there was “no need to consider the question of prejudice”).

5 Oracle identifies the date of the Court’s claim construction at the starting point for the
 6 diligence inquiry; however, the inquiry does **not** begin when a new basis to amend is actually
 7 discovered, but instead focuses on “whether the party was diligent *in discovering the basis for*
 8 *amendment.*” *Acer, Inc. v. Tech. Props.*, Nos. 5:08-cv-00877, 00882, 05398, 2011 U.S. Dist.
 9 LEXIS 55774 at *8 (N.D. Cal. May 13, 2011) (emphasis added) (quoting *West v. Jewelry*
 10 *Innovations, Inc.*, No. 07-cv-1812, 2008 U.S. Dist. LEXIS 84928 at *7 (N.D. Cal. Oct. 8, 2008).)

11 As stated in Google’s opposition to Oracle’s Précis letter in this dispute (Dkt. No. 758 at
 12 2), Google’s Patent L.R. 4-2 disclosure included a proposed construction of “runtime” (“during
 13 execution of the virtual machine instructions”) **over a year ago** that is nearly identical to the
 14 Court’s recent construction (“during execution of one or more virtual machine instructions”).
 15 Oracle now argues that “[t]he Court’s construction is broader than and anything but ‘nearly
 16 identical’ to Google’s proposed claim construction.” (Motion at 5.) But the Court’s
 17 Supplemental Claim Construction Order only modified Google’s construction because it found
 18 the word “the” to be “unnecessary and confusing” (Dkt. 704 at 9); the Order does not suggest
 19 that the scope of “runtime” is any different than Google’s proposal. Moreover, even if the
 20 Court’s construction of runtime is broader than Google’s proposal, as Oracle argues, then any
 21 attempt to present an infringement case that accounted for Google’s construction would have
 22 necessarily accounted for the Court’s construction as well.

23 In sum, Oracle fails to show that it ever considered anything other than its own
 24 construction—which the Court held “would render the phrase meaningless.” (*Id.* at 7.) Instead,
 25 it stuck its head in the sand. Now Oracle tells the Court that its entire team of attorneys and
 26 experts were caught completely off guard by the Court’s construction. That is not credible. The
 27 Court did not cook up an entirely original construction that was “not anticipated,” but rather one
 28

1 that slightly clarifies Google's original proposal. Thus, Oracle's failure to anticipate was simply
 2 a lack of diligence.

3 **B. Oracle's Amendments Are Extremely Prejudicial to Google**

4 The Patent Local Rules provide that, *even upon a timely showing of good cause*, leave to
 5 amend contentions due to a Court's claim construction should be denied if there is undue
 6 prejudice to the non-moving party. Patent L.R. 3-6(a). The parties are weeks away from trial,
 7 and allowing Oracle to redo its infringement theory for the '205 patent at this point would go
 8 miles beyond the line in the sand for "undue prejudice" under the Patent Local Rules. "The
 9 Patent Local Rules were designed, among other reasons, to prevent the parties from shifting their
 10 theories late in discovery, leaving the opposing party with little time to conduct discovery on a
 11 new theory." *Golden Hour Data Sys., Inc. v. Health Servs. Integration, Inc.*, No. 06-cv-07477,
 12 2008 U.S. Dist. LEXIS 75495 at *13 (N.D. Cal. July 1, 2008) (citing *O2 Micro*, 467 F.3d at 1365
 13 Therefore, even if the Court concludes that its claim construction provides good cause for
 14 Oracle's amendments and supplementation, Oracle's Motion should be denied as unduly
 15 prejudicial given that they come on the eve of trial.

16 **C. Should Oracle's Motion be Granted, Google Seeks Leave to Amend its Invalidity
 17 Contentions, As Well as its Non-Infringement and Invalidity Expert Reports**

18 As is recognized by the very structure of the Patent Local Rules, invalidity contentions
 19 are a reflection of infringement contentions. Here, Oracle's new infringement theory implicates
 20 numerous "install time" implementations in the prior art, including at least Sun's own Java
 21 platform, and publications by James Gosling, Stavros Macrakis, L.P. Deutsch & Allan M.
 22 Schiffman. Thus, if the Court grants Oracle's motion, Google should also be granted leave to
 23 supplement its invalidity contentions and expert reports in response.

24 **III. CONCLUSION**

25 Google respectfully requests that Oracle's motion be denied as moot, in view of the
 26 Court's recent orders. But should the Court evaluate Oracle's motion on the merits, Google
 27 respectfully requests the motion be denied for the reasons stated herein. Otherwise, Google
 28 requests leave to supplement its invalidity contentions and expert reports in response.

1
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